UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/202,455	12/15/98	YAMAGUCHI K	FJN-070

HM12/1104

TESTA HURWITZ & THIBEAULT
125 HIGH STREET
HIGH STREET TOWER
BOSTON MA 02110

EXAMINER	
HAMUD,F	
ART UNIT	**PAPER NUMBER**
1646	6

DATE MAILED: 11/04/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

File Copy

Office Action Summary	Application No. 09/202,455	Applicant(s) Yamaguchi et al
	Examiner Fozia Hamud	Group Art Unit 1646

☒ Responsive to communication(s) filed on *Jul 2, 1999*.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *1* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-64* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-64* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

x Notice to comply with sequence rules.

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. This application is a 371 of PCT/JP98/01728. For applications filed under 371, PCT rules for lack of unity apply.

2. This application contains inventions or groups of inventions which are not so linked as to form a single inventive concept. Under PCT Rule 13.1 the following combinations of claims of different categories are permissible and restriction to one of the following combinations is required:

I. Claims 1, 8-16, 21-31, 36-44, drawn to an isolated nucleic acid encoding an OCIF protein, the encoded OCIF protein, and a method of making the OCIF protein.

II. Claims 6-7, 49-64, drawn to an antibody to OCIF protein.

III. Claim 2, drawn to a process of making OCIF protein, by culturing stromal cells originating from bone marrow.

IV. Claims 3-5, 33-35, 46-48, drawn to a screening method for a substance which specifically binds to OCIF protein.

V. Claims 17-20, 32, 35, 45, 48, a screening method for a substance which controls the expression of the OCIF protein.

The inventions listed as Groups I-IV do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons:

Group I and II are drawn to separate, distinct inventions and are distinguished from each other because the special technical features which define them by chemical and physical characteristics i.e structure/function, as well as biological functions are different and these special technical features are not shared by each invention. Since these special technical features are not shared by each product and since common features do not establish an advance over prior art, the inventions of Groups I and II do not form a single inventive concept within the meaning of Rule 13.2.

Groups III-V are drawn to methods different in design and performance, and which do not share the same or corresponding special technical feature which define the contribution of each invention. The methods of Groups III to V do not share a corresponding special technical feature, because the method of making the OCIF protein as in Group III is different in the steps and required reagents, from a screening method for a substance which specifically binds to OCIF as in Group IV or a screening method for a substance which controls the expression of OCIF as in Group V. The methods of Groups IV and V do not share a corresponding special technical feature, because the screening method for a substance which specifically binds to OCIF as in Group IV is different in the steps and required reagents, from a screening method for a substance which controls the expression of OCIF AS in Group V. Since these special technical features are not shared by each process, and since the common features do not establish an advance over the prior art, the inventions of Groups III-V do not form a single inventive concept within the meaning of PCT Rule 13.2.

The invention of Group I is separate and distinct from the invention of Group III, because the protein of Group I may be produced in methods other than the method in Group III, such as by chemical synthesis.

The invention of Group I is separate and distinct from the inventions of Groups IV and V because the invention of Group I may be used in other methods other than that of Group III, such as the polypeptide in Group I can be used as antigens in production of antibodies or can be used diagnostically.

The invention of Group II is separate and distinct from the inventions of Groups III-IV because the antibody of Group II is neither used nor produced in the methods of Groups III-IV.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

3. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Applicant is given ONE MONTH, or THIRTY DAYS, whichever is longer, from the mailing date of this letter within which to comply with the sequence rules, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). In no case may an applicant extend the period for reply beyond the SIX MONTH statutory period. Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia Hamud whose telephone number is (703) 308-8896. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Fozia Hamud
Patent Examiner
Art Unit 1646
October 27, 1999

Prema Mertz
PREMA MERTZ
PRIMARY EXAMINER

Application No. 09/202,455

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821 - 1.825 for the following reason(s):

☒ 1. This application clearly fails to comply with the requirements of 37 CFR 1.8 1.825. Applicant's attention is directed to these regulations, published at 114 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.

☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 CFR 1.821(c).

☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).

☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitte However, the content of the computer readable form does not comply with the requirements of 37 CFR 1.822 and/or 1.823, as indicated on the attached copy of marked-up "Raw Sequence Listing."

☐ 5. The computer readable form that has been filed with this application has bee found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as requi by 37 CFR 1.825(d).

☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).

☐ 7. Other: _____

Applicant must provide:

☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing"

☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification

☒ A statement that the content of the paper and computer readable copies are the s and, where applicable, include no new matter, as required by 37 CFR 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d)

For questions regarding compliance with these requirements, please conta

For Rules Interpretation, call (703) 308-1123
For CRF submission help, call (703) 308-4212
For PatentIn software help, call (703) 557-0400

Please return a copy of this notice with your response.